



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,277	12/28/1999	HIROSHI KOIKE	500-38037XOO	9791

20457 7590 05/08/2002

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,277

Applicant(s)

KOIKE ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 6, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 1999 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 have been examined.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 706 (see fig. 7). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

Specification

4. The disclosure is objected to because of the following informalities: typographical error, change "Fig. 6 is shows" to "Fig. 6 shows" (see pg. 17, line 16).

Appropriate correction is required.

Claim Objections

5. Claim 6 is objected to because of the following informalities: typographical error; change "digital set" to "digital content set" (see line 11). Appropriate correction is required.
6. Claim 11 is objected to because of the following informalities: duplicate phrase; remove the additional phrase: "for collecting sales information" (see lines 3-4). Appropriate correction is required.

Art Unit: 3621

7. Claim 13 is objected to because of the following informalities: typographical error; change “digital sent” to “digital content sent” (see line 12). Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US 2002/0002468 to Spagna et al.

Spagna et al. disclose instructing distribution of digital contents according to a distribution schedule, distributing digital contents according to the distribution schedule indicated; and selling a particular digital content selected from the digital contents distributed (see section [0930], lines 12-26).

10. Claims 2, 6, 10, 13, 16 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5860068 to Cook.

Cook discloses receiving identifying information of a particular digital content selected by a customer (see col. 7, lines 20-21, 26-31; col. 11, line 24), transmitting a distribution request for the digital content selected by the customer (see col. 11, lines 27-28), distributing the digital

Art Unit: 3621

content requested for distribution (see col. 10, lines 24-63), and selling the digital content distributed (see col. 7, lines 36-41).

Referring to claim 6, Cook discloses receiving identifying information of a particular digital content selected by a customer (see col. 7, lines 20-21, 26-31), transmitting a distribution request for the digital content selected by the customer to a distribution management device (see col. 6, lines 25-32; col. 7, lines 38-43; col. 11, lines 27-28), relaying a distribution request from a vending device to a content database device (i.e. "disk farm") and distributing the digital content sent from the content database device according to the distribution request to the vending device, i.e. user's PC (see col. 10, lines 58-63), receiving the distribution request relayed from the distribution management device (see col. 7, lines 38-43), transmitting the digital content requested for distribution to the distribution management device (see col. 11, lines 27-28), and selling the digital content distributed from the distribution management device (see col. 11, lines 27-28).

Referring to claim 10, Cook discloses a selecting section for receiving identifying information of a particular digital content selected by a customer (see col. 7, lines 26-35), a distribution requesting section for transmitting a distribution request for the digital content selected by the customer (see col. 7, lines 38-43 and col. 11, lines 27-28), a requested content distributing section for distributing the digital content requested for distribution (see col. 10, lines 23-63), and a sales section for selling the digital content distributed (see col. 7, lines 36-43).

Referring to claims 13 and 19, Cook discloses a selecting section for receiving identifying information of a particular digital content selected by a customer (see col. 7, lines 26-35), a distribution requesting section for transmitting a distribution request for the digital content

Art Unit: 3621

selected by the customer to a distribution management device (see col. 6, lines 25-44; col. 7, lines 38-43; col. 11, lines 27-28), a distribution request relay section for relaying a distribution request from a vending device to a content database device (see col. 7, lines 26-31; col. 11, line 21), distributing the digital content sent from the content database device according to the distribution request to the vending device (see col. 10, lines 58-63), a requested content distribution section for receiving the distribution request relayed from the distribution management device (see col. 7, lines 38-43) and transmitting the digital content requested for distribution to the distribution management device (see col. 11, lines 27-28) and a sales section for selling the digital content distributed from the distribution management device.

Referring to claim 16, Cook discloses a selecting section for receiving identifying information of a particular digital content selected by a customer (see col. 7, lines 26-35), a requested content distributing section for distributing the digital content requested for distribution (see col. 10, lines 23-63), and a sales section for selling the digital content distributed (see col. 7, lines 36-43).

11. Claims 4, 11 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by European Patent No. 0809221A2 to Poggio.

Poggio discloses collecting sales information of digital contents sold (see col. 2, lines 50-53), and calculating a license fee of each digital content according to the sales information collected and remitting the fee to a content holder of the digital content (see col. 4, lines 39-45 and col. 6, lines 13-16). Note. Poggio discloses a system that provides information on associated licensing fees for customer selected products. Poggio does not explicitly state that the

Art Unit: 3621

fees were calculated; however, the fees must have been calculated prior to providing it to the customer.

Referring to claims 11 and 17, Poggio discloses a processing section for collecting sales information of digital contents sold (see col. 2, lines 49-53), a license fee section for calculating a license fee of each digital content according to the sales information collected and remitting the fee to a content holder of the digital content (see col. 4, lines 39-45; col. 6, lines 13-16). Note. Poggio discloses a system that provides information on associated licensing fees for customer selected products. Poggio does not explicitly state that the fees were calculated; however, the fees must have been calculated prior to providing it to the customer.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5799157 to Escallon and European Patent No. 0809221A2 to Poggio.

Escallon discloses generating a digital content by digitizing an original book (see col. 3, lines 11-15), and displaying the contents of the digital content (see col. 6, lines 13-14). Escallon does not disclose requesting confirmation of contents thereof, indicating accumulation of the digital content recognized, transmitting a message to indicate whether or not the contents thereof are to be recognized, receiving and accumulating the digital content indicated. Poggio disclose

Art Unit: 3621

requesting confirmation of contents, indicating accumulation of the digital content recognized, transmitting a message to indicate whether or not the contents thereof are to be recognized (see col. 9, lines 48-55), receiving and accumulating the digital content (see col. 10, lines 38-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Escallon to include the steps of requesting confirmation of contents, indicating accumulation of the digital content recognized, transmitting a message to indicate whether or not the contents thereof are to be recognized, receiving and accumulating the digital content. One of ordinary skill in the art would have been motivated to do this because it allocates digital information within the network.

14. Claims 5, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al. in view of Cook.

Spagna et al. disclose instructing distribution of digital contents according to a distribution schedule, and distributing digital contents according to the distribution schedule (see section [0930], lines 12-26). Spagna et al. do not disclose a distribution management device, distributing digital contents to a vending device according to the distribution schedule indicated by a content database device or selling a particular digital content selected from the digital contents distributed from the distribution management device. Cook discloses a distribution management device (see col. 6, lines 25-44), distributing digital contents to a vending device (i.e. "consumer's PC") by a content database device, i.e. "disk farm" (see col. 10, lines 58-63, col. 11, line 4, col. 4, lines 42-45), and selling a particular digital content selected from the digital contents distributed from the distribution management device (see col. 7, lines 36-43). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art

Art Unit: 3621

to modify the method disclose by Spagna to include a distribution management device, distributing digital contents to a vending device according to the distribution schedule indicated by a content database device and selling a particular digital content selected from the digital contents distributed from the distribution management device. One of ordinary skill in the art would have been motivated to do this because it ensures that the digital content is distributed at the proper time.

Referring to claims 12 and 18, Spagna et al. disclose a distribution control section for indicating distribution of digital contents according to a distribution schedule and distributing digital contents to a vending device according to the distribution schedule (see section [0930], lines 12-26). Spagna do not expressly disclose a distributing section for distributing digital contents to a vending device according to the distribution schedule indicated by a content database device or a sales section for selling a particular digital content selected from the digital contents distributed from the distribution management device. Cook discloses a distributing section for distributing digital contents to a vending device (i.e. user's PC) according to the distribution schedule indicated by a content database device, i.e. "disk farm", and a sales section for selling a particular digital content selected from the digital contents distributed from the distribution management device (see col. 7, lines 36-43). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the methods disclose by Spagna et al. to include a distributing section for distributing digital contents to a vending device according to the distribution schedule indicated by a content database device or a sales section for selling a particular digital content selected from the digital contents distributed from

Art Unit: 3621

the distribution management device. One of ordinary skill in the art would have been motivated to do this because it ensures that the digital content is distributed at the appropriate time.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al. and Cook as applied to claim 5 above, and further in view of Escallon.

Escallon discloses generating a digital content by digitizing an original book (see col. 3, lines 11-15) and displaying the contents of the digital content (see col. 6, lines 13-14). Escallon does not disclose requesting a recognition device for confirmation of contents thereof, receiving from the recognition device a message indicating whether or not the contents of the digital content are to be recognized, indicating accumulation of the digital content recognized to a content database device, transmitting a message to indicate whether or not the contents thereof are to be recognized to the digitalizing device or receiving and accumulating the digital content generated by the digitizing device. Poggio discloses requesting a recognition device for confirmation of contents thereof, receiving from the recognition device a message indicating whether or not the contents of the digital content are to be recognized, indicating accumulation of the digital content recognized to a content database device, transmitting a message to indicate whether or not the contents thereof are to be recognized to the digitalizing device (see col. 8, lines 20-23; col. 9, lines 34-55) and receiving and accumulating the digital content generated by the digitizing device (see col. 10, lines 38-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Escallon to include the steps of requesting a recognition device for confirmation of contents thereof, receiving from the recognition device a message indicating whether or not the contents

Art Unit: 3621

of the digital content are to be recognized, indicating accumulation of the digital content recognized to a content database device, transmitting a message to indicate whether or not the contents thereof are to be recognized to the digitalizing device or receiving and accumulating the digital content generated by the digitizing device. One of ordinary skill in the art would have been motivated to because it allocates digital information within the network.

16. Claims 8, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poggio in view of Cook.

Poggio discloses collecting sales information of digital contents sold by a vending device (see col. 2, lines 50-53), relaying the sales information sent from the vending device to a content database device (see col. 10, lines 35-37) and calculating a license fee of each digital content according to the sales information relayed from the content database device and remitting the fee to a content holder of the digital content (see col. 4, lines 39-45; col. 6, lines 13-16). Note. Poggio discloses a system that provides information on associated licensing fees for customer selected products. Poggio does not explicitly state that the fees were calculated; however, the fees must have been calculated prior to providing it to the customer. Poggio does not expressly disclose sending the sales information to a distribution management device. However, Cook discloses sending the sales information to a distribution management device (see col. 7, lines 38-43). Although, Cook does not explicitly state that the sales information is sent to the management device; he indirectly discloses this step. Notice, after the user selects the items, the order is assigned a job number by the management system. The management system must first receive the order information or sales information before assigning the job number. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the

Art Unit: 3621

art to modify the methods disclose by Poggio to send the sales information to a distribution management device. One of ordinary skill in the art would have been motivated to do this because management device controls and maintains transaction information (see Cook, col. 6, lines 34-44).

Referring to claims 14 and 20, Poggio discloses a processing section for receiving distributed content for collecting sales information of digital contents sold by a vending device (see col. 2, lines 49-53), a processing section for relaying distribution content for relaying the sales information sent from the vending device to a content database device (see col. 10, lines 35-37) and a license section for calculating a license fee of each digital content according to the sales information relayed from the content database device and remitting the fee to a content holder of the digital content (see col. 4, lines 39-45; col. 6, lines 13-16). Note. Poggio discloses a system that provides information on associated licensing fees for customer selected products. Poggio does not explicitly state that the fees were calculated; however, the fees must have been calculated prior to providing it to the customer. Poggio does not expressly disclose sending the sales information to a distribution management device. However, Cook discloses sending the sales information to a distribution management device (see col. 7, lines 38-43). Although, Cook does not explicitly state that the sales information is sent to the management device; he indirectly discloses this step. Notice, after the user selects the items, the order is assigned a job number by the management system. The management system must first receive the order information or sales information before assigning the job number. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the methods disclose by Poggio to send the sales information to a distribution management device. One of

Art Unit: 3621

ordinary skill in the art would have been motivated to do this because management device controls and maintains transaction information (see Cook, col. 6, lines 34-44).

17. Claims 9, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al. and Poggio in view of Cook.

Spagna et al. disclose instructing distribution of digital contents according to a distribution schedule and distributing digital contents according to the distribution schedule indicated (see section [0930], lines 12-26). Spagna et al. do not disclose a distribution control section, a distribution section or a sales section for selling a particular digital content selected from the digital contents distributed. Poggio discloses a distribution control section and a distribution section for managing distribution of digital contents and for distributing the digital contents (see col. 4, lines 35-46). Cook discloses a sales section for selling a particular digital content selected from the digital contents distributed (see col. 7, lines 26-31, 36-41). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the methods disclosed by Spagna et al. to include a distribution control section, a distribution section and a sales section for selling a particular digital content selected from the digital contents distributed. One of ordinary skill in the art would have been motivated to do this because it provides means for allocating digital contents within a network.

Referring to claims 15 and 21, Spagna et al. disclose indicating distribution of digital contents according to a distribution schedule and distributing digital contents according to the distribution schedule indicated (see section [0930], lines 12-26). Spagna et al. do not disclose a distribution control section, a distribution section or a sales section for selling a particular digital

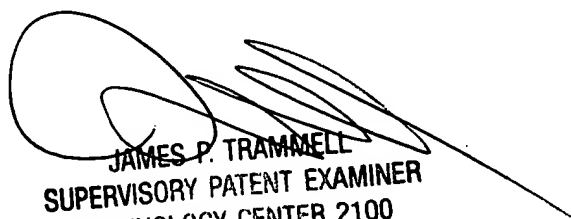
Art Unit: 3621

content selected from the digital contents distributed. Poggio discloses a distribution control section and a distribution section for managing distribution of digital contents and for distributing the digital contents (see col. 4, lines 35-46). Cook discloses a sales section for selling a particular digital content selected from the digital contents distributed (see col. 7, lines 26-31, 36-41). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the methods disclosed by Spagna et al. to include a distribution control section, a distribution section and a sales section for selling a particular digital content selected from the digital contents distributed. One of ordinary skill in the art would have been motivated to do this because it provides means for allocating digital contents within a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications, 703-746-7240 for Non-Official/Draft communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100